

PATENT

App. Ser. No.: 09/955,232
Atty. Dkt. No. ROC920010197US1
PS Ref. No.: IBMK10197

REMARKS

This is intended as a full and complete response to the Office Action dated July 29, 2005, having a shortened statutory period for response set to expire on October 29, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-32 are pending in the application. Claims 1-32 remain pending following entry of this response. Claims 1-3, 6, 8, 11-13, 15-17, 19, 23-24, and 27-28 have been amended. The claims have been amended for clarification. Because the claims have been amended for clarification, and not to overcome a rejection by the Examiner, Applicant submits that the claims as amended are entitled to a full range of equivalents. Applicant submits that the amendments and new claims do not introduce new matter.

Claim Objections

Claims 2 and 8 are objected to. Applicant respectfully submits that the amendment to the claims obviates the objections. Accordingly, withdrawal of the objections is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claim 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by *Wakai et al.* (US 2002/0065871A1, hereinafter "*Wakai*"). Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

PATENT

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In this case, *Wakai* does not disclose "each and every element as set forth in the claim". For example, *Wakai* does not disclose transforming a print file in accordance to stored print options. The Examiner argues that *Wakai* discloses transforming a print file in accordance to stored print options at Para. 0275, Lines 1-3 and Para. 0241. However, the cited sections are in fact directed to executing a process for an object.

The first cited portion, Para. 0275, Lines 1-3 describes management data such as data format and size of an Object. The Object is located in an Action, which is part of a Job. See Paras. 0266, 0272. The Job may be generated when a user instructs the printing of specific data at a designated time. See Para. 280. Processes performed on the Object may include sending, deleting, scanning, extracting data, printing, filing, changing priority converting, and notifying. See Para. 0273. As depicted in Figure 1, the Job is generated by a server and placed in a database.

The second portion cited by the Examiner (Para. 0241) describes a daemon that executes a corresponding process for a Job in the database when the execution condition for a Job is satisfied. For example, when a time designated by a user is reached, the job for the printing process may be performed. See Para. 0283. Thus, *Wakai* describes a daemon which may be used to execute Jobs scheduled by a user. Each Job contains an Object and formatting data about the object. However, *Wakai* does not describe that the object is transformed in any manner, nor that the formatting data is used to transform the object. Accordingly, *Wakai* does not describe transforming a print file in accordance to stored print options. Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

PATENT

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Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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